REMARKS

Rejections Under 35 U.S.C. Sec. 102

The examiner's application of Ogawa '874 under Sec. 102 against claims 1, 5, 12, 16 and 23 is believed to have stemmed from a mistaken interpretation of the claims. Ogawa, as required under Sec. 102, does not show each and every claimed feature. In particular, the mistake concerns the claim recital, "a plurality of stored file formats of the data file." As the examiner points out, Ogawa '874 does teach receiving a request for a data file in a requested format and subsequently translating the data file to the requested format – but in the conversion process, two translation steps are required. Ogawa '874 also recognizes potential difficulties of translating certain native file formats to a requested file format due to possible inherent incompatibilities between the two formats. He addresses that problem first by converting the native format to a "common" or "universal" format suitable for convenient translation to any requested file format thereby obviating potential translation difficulties, and then translating the "common" or "universal" format to the requested format. However, each time a user desires a stored data file (assuming a translation is required), the time-consuming two-step translation process is required. An embodiment of applicant's claim 1, on the other hand, uses a one-step translation process. Because claim 1 provides for storage of multiple pre-formatted versions of a requested data file, i.e., "a plurality of file formats of said data file," format translation merely involves a *selection* of an optimal format for conversion to the requested format thereby avoiding one of the time-consuming conversion steps of Ogawa '874. Thus, Ogawa does not teach a "plurality of stored filed formats" of a stored data file from which to determine an optimal file format to generated a data file in a requested format. It thus follows that Ogawa fails to show an optimized list of file formats, as recited in claims 5 and 16.

Although this distinction was present in the preamble, the body of original claim recitals may have been unclear. Substitute claims 1, 12, and 23 better define the distinction. Reconsideration is respectfully requested.

The examiner also rejected claims 1-5, 7-8, 12-16, 18-19, and 23 under 35 U.S.C. Sec. 102(b) as being anticipated by Probert '918. For reasons explained above, this rejection

2

too should be withdrawn because "all elements" of the claim are not shown in the applied reference. See MPEP, Sec. 2131. Probert '918 does not teach "a plurality of stored formats" of a requested data file from which one can be selected to perform a translation to a requested format. Instead, Probert '918 provides "on-the-fly conversion between a [native] format ... to a [requested] format" desired by a user. See Probert '918, col. 3, lines 18-20. The statement in Probert '918 at col. 10, lines 29-34 that the filter driver may "keep a file in different formats depending on access history" does not teach selecting one of many formats for use in a subsequent translation to a requested format. In Probert, such files are kept in such different formats based on prior access history and are sent directly to the requester, i.e., no further translation would be required. Similarly, the Native Structured Storage (NSS) referred to by the examiner in the rejection of claim 7 (page 5 of the examiner's comments) does not teach maintaining the requested data file in plural formats, and then choosing one of the formatted representations of the data file to perform a format translation to a requested file format.

Since no pre-stored versions of the desired data file in different formats are taught, the rejection based on Probert '918 should also be withdrawn. It also follows that Probert '918 fails to teach an optimized list of file format recited in the claims. Likewise, the rejection applied against independent claims 12 and 23 should also be withdrawn.

Rejection Under 35 U.S.C. Sec. 103(a)

For reasons advanced above, the rejection under 35 U.S.C. Sec. 103(a) asserted against dependent claims 6, 9-11, 17, and 20-22 should also be withdrawn. Applicant notes but does not agree that Atkinson '124 was applied because it purportedly "reads on a format type list indexed by a requested file format." Even if Atkinson '124 shows such a list, nothing in Probert or Atkinson would properly suggest combining their teachings to render obvious using the list of selected ones of multiple formatted versions of a data file to select a file having an optimal format from which to generate a file in a requested format.
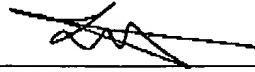
Conclusion

An associate Power of Attorney accompanies this paper.

No fees are due with this reply.

3

Serial No. 09/730,219
July 22, 2004

Applicants stand ready to assist in resolving any further issues that might arise in connection with this response.

Respectfully submitted,
McINTYRE HARBIN & KING

Lawrence Harbin, Reg. No. 27,644
500 Ninth Street, S.E., Washington, DC 20003
202.546-1100 tel. 202.543.9230 fax

4